

Application No. 10/750,402
Amendment dated May 20, 2005
Reply to Office Action of February 22, 2005

REMARKS

In response to the restriction requirement mailed February 22, 2005, Applicants respectfully elect Claims 34 – 45 and 47 – 51 to be prosecuted by way of the present application. This election is made **without traverse**. Applicants specifically reserve the right to seek patent protection for non-elected subject matter by divisional application.

Claims 1 – 33 have been canceled as a result of this election.

Claim 46 was canceled in a previous response.

Therefore, claims 34 – 45 and 47 – 51 are presented for Examiner Chapman's consideration.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested.

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Response to Rejections

By way of the Office Action mailed 02/22/2005, claims 34 – 35, 38, 40 – 43, 45, 47 – 48, 50 and 51 stand rejected under 35 U.S.C. § 102 as allegedly being anticipated and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*). This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 referencing *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Also, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” M.P.E.P. § 2131 (citing *Richardson*, 868 F.2d at 1236 (Fed. Cir. 1989)).

As to claim 34, *Allen* does not teach each and every element either expressly or inherently. Specifically *Allen* does not teach an absorbent assembly positioned between the outer layer and the elastic inner layer, wherein the absorbent assembly includes a topsheet layer, a core layer and a barrier layer as required by Applicants’ claim 34.

Allen states that “[t]he absorbent core 18 may be made from a variety of commonly used materials such as comminuted wood pulp, typically referred to as airfelt. If desired, the absorbent core 18 may further contain absorbent gelling materials as is commonly used in the art.” (col. 3: lines 59-64).

Allen does NOT teach an absorbent assembly including a topsheet layer, a core layer and a barrier layer as required by Applicants’ claim 34. Therefore, the identical invention is NOT shown in as complete detail as is contained in the claim as required by M.P.E.P. § 2131 and the Examiner has failed to meet the burden of § 102.

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Therefore, Applicants respectfully request that the rejection to claim 34, and claims 35, 38, 40 – 43, 47 – 48, 50 and 51, which depend therefrom, be withdrawn.

By way of the Office Action mailed 02/22/2005, claim 34 stands rejected under 35 U.S.C. § 102 as allegedly being anticipated and thus unpatentable over U.S. Patent Number 5,269,775 to Freeland *et al.* (*Freeland*). This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

As to claim 34, *Freeland* does not teach each and every element either expressly or inherently. Specifically *Freeland* does not teach an absorbent assembly positioned between the outer layer and the elastic inner layer, wherein the absorbent assembly includes a topsheet layer, core layer and a barrier layer as required by Applicants' claim 34.

The Examiner cites column 6, lines 34-35 and 45-49 of *Freeland* to find a "barrier layer." (OA at page 3). This citation describes the backsheet 24 of *Freeland*. *Freeland* states, "The core 26 may be adhesively joined to the topsheet 22 and/or backsheet 24 respectively. ..." (col. 6: lines 34-36). Therefore, the backsheet 24 of *Freeland* is clearly NOT a part of the absorbent assembly as required by Applicants' claim 34.

Freeland does NOT teach an absorbent assembly including a topsheet layer, a core layer and a barrier layer as required by Applicants' claim 34. Therefore, the identical invention is NOT shown in as complete detail as is contained in the claim as required by M.P.E.P. § 2131 and the Examiner has failed to meet the burden of § 102. Applicants respectfully request that the rejection to claim 34 be withdrawn.

By way of the Office Action mailed 02/22/2005, claim 49 stands rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*) in view of U.S. Patent Number 5,269,775 to Freeland *et al.* (*Freeland*). This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. M.P.E.P. § 2142, 2143.

Claim 49 depends from claim 34. Claim 34, and therefore claim 49, requires an absorbent assembly positioned between the outer layer and the elastic inner layer, wherein the absorbent assembly includes a topsheet layer, a core layer and a barrier layer, as discussed above. Neither *Allen* nor *Freeland*, alone or in combination, teach or suggest a disposable absorbent garment having the claimed absorbent assembly. Therefore, a *prima facie* case of obviousness has not been established as regarding claim 49 because the prior art references do not teach or suggest all the claim limitations. Applicants respectfully request the rejection be withdrawn.

Additionally, there is no suggestion or motivation in *Allen* or *Freeland*, alone or in combination, to modify or combine one with the other. The Examiner asserts that it “would therefore be obvious [to one] having ordinary skill in the art at the time the invention was made to construct the garment of *Allen* with an outer layer having a greater width in the lateral direction as taught by *Freeland* to provide a more comfortable fit to the wearer while the garment is in use.” Applicants respectfully disagree with the sufficiency of the Examiner’s purported motivation.

The Examiner has provided no citation in either reference to suggest that one would be motivated to combine the teachings of *Freeland* with *Allen*. The Examiner has stated the purported motivation, i.e., “to provide a more comfortable fit.” However, *Allen* has already provided a solution to a more comfortable fit, that is, to provide a topsheet that has a low contact force. There is no teaching in *Allen* to suggest that an outer layer having a greater width in the lateral direction would provide a more comfortable fit.

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Freeland teaches foreshortening of the topsheet relative to the backsheet to create a void therebetween. This teaching does not relate to comfort. Therefore, it appears the Examiner has undertaken improper hindsight rationalization to find motivation where none exists.

Even if the references *could* be modified or combined, the resultant modification or combination is not rendered obvious unless the prior art teaches or suggest the desirability of the modification or combination. M.P.E.P. § 2142, 2143. The Examiner has not made a *prima facie* case of obviousness. Applicants respectfully request this rejection be withdrawn.

By way of the Office Action mailed 02/22/2005, claims 36 and 37 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*) in view of U.S. Patent Number 4,756,709 to Stevens *et al.* (*Stevens*). This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

Claims 36 and 37 depend from claim 34. Claim 34, and therefore claims 36 and 37, require an absorbent assembly positioned between the outer layer and the elastic inner layer, wherein the absorbent assembly includes a topsheet layer, a core layer and a barrier layer, as discussed above. Neither *Allen* nor *Stevens*, alone or in combination, teach or suggest a disposable absorbent garment having an absorbent assembly as claimed. Therefore, a *prima facie* case of obviousness has not been established as regarding claims 36 and 37 because the prior art references do not teach or suggest all the claim limitations. Applicants respectfully request the rejection be withdrawn.

The Examiner acknowledges that *Allen* fails to address a stretchable outer layer. The Examiner looks to *Stevens* for the claimed outer layer of claims 36 and 37. However, no *prima facie* case of obviousness has been established because there is no suggestion or motivation to modify the references or combine reference teachings.

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The Examiner cites column 3, lines 49-52 of *Stevens* which states, "The outer cover of the disposable diaper of the present invention is not only breathable, but is resiliently stretchable, thus providing both the benefits of dry skin and a form-fitting, anatomically self-adjusting disposable diaper that conforms to the baby's shape." This statement alone does NOT provide proper motivation to combine *Stevens* with *Allen*.

The Examiner indicates that the motivation to combine references is to produce a **diaper providing a conforming fit**. (Office Action at page 7). Whether or not both references discuss conforming fit is irrelevant. The fact that the references mention similar problems and *can* be modified or combined does NOT render the resultant modification or combination obvious unless the prior art teaches or suggest the desirability of the modification or combination. Since, the references do NOT provide motivation to combine, the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

Not only is there no suggestion or motivation to combine, adding the outer cover of *Stevens* to the article of *Allen* would **frustrate** one of the purposes of *Allen*, i.e., to create a void space between the topsheet and the absorbent core. Therefore there would be no reasonable expectation of success as required by § 103.

Allen states that "ideally the longitudinally contracted and foreshortened topsheet 12' will generally conform to the wearer, while the larger radius of curvature of the absorbent core 18' allows the core 18' to **fall away** from the topsheet 12' and create the void space 28' thereinbetween." (col. 13: lines 1-6)

Stevens provides a **resiliently stretchable outer cover** to provide a "form-fitting, anatomically self-adjusting disposable diaper that conforms to the baby's shape." (col. 3: lines 48-52). If the outer cover of *Stevens* provides a conforming fit, one skilled in the art would not, therefore, be motivated to add the outer cover of *Stevens* to the article of *Allen*. Doing so would frustrate the object of *Allen*, i.e., to create a void space, because the resiliently stretchable outercover of *Stevens* would not allow the core 18', of *Allen*, to fall away from the topsheet 12' and create the void space 28'. Therefore, no *prima facie* case of

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obviousness has been established and Applicants respectfully request this rejection be withdrawn.

By way of the Office Action mailed 02/22/2005, claims 39 and 44 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*) in view of U.S. Patent Number 5,817,086 to Kling (*Kling*). This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

Claims 39 and 44 depend from claim 34. Claim 34, and therefore claims 39 and 44, require an absorbent assembly positioned between the outer layer and the elastic inner layer, wherein the absorbent assembly includes a topsheet layer, a core layer and a barrier layer, as discussed above. Neither *Allen* nor *Kling*, alone or in combination, teach or suggest a disposable absorbent garment having an absorbent assembly as claimed. Therefore, a *prima facie* case of obviousness has not been established as regarding claims 39 and 44 because the prior art references do not teach or suggest all the claim limitations. Applicants respectfully request the rejection be withdrawn.

As to claim 39 specifically, neither *Allen* nor *Kling*, alone or in combination, teach or suggest all the claim limitations set forth in Applicants' claim. The Examiner acknowledges that *Allen* fails to teach the use of liquid permeable outer layer as required by claim 39. The Examiner looks to one component of the bottom layer laminate of *Kling* to find a liquid permeable outer layer.

Applicants respectfully disagree with this line of reasoning. The bottom layer 5 of *Kling* is liquid-impermeable. (col. 3: line 26). The bottom layer 5 can also consist of a laminate of thermoplastic layer and a fibers fabric. (col. 3: lines 63-65). A laminate of this nature is NOT liquid permeable regardless of whether one component of the laminate is permeable. The Examiner has failed to make a *prima facie* case of obviousness with respect to claim 39. Applicants respectfully request that this rejection be withdrawn.

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As to claim 44 specifically, the Examiner acknowledges that *Allen* fails to teach the use of liquid impermeable inner layers. However, the Examiner asserts that it would have been obvious to construct the inner layer and opening of *Allen* with a liquid impermeable material as taught by *Kling* to provide a dry skin-contacting surface to the wearer to reduce skin irritation.

The Examiner has provided no citation to either *Allen* or *Kling* evidencing the motivation or suggestion to make the combination. This appears to be post hoc rationalization to justify the combination.

Allen specifically teaches away from combination by teaching that the topsheet is liquid pervious to permit liquids to readily penetrate through. (col. 6: lines 16-18). One skilled in the art would not find motivation in *Allen* to add the liquid impermeable inner layer of *Kling*.

Kling discusses a liquid-impermeable topsheet **in conjunction** with the **specific** embodiment illustrated in Figs. 5 and 6. In that embodiment, there is a large front opening 431 through which urine is to pass, thus allowing the topsheet to be liquid-impermeable. However, *Allen* specifically teaches that, “the size of the passageway 21’ is a balance between the **minimum** size necessary to accommodate variations in the placement of the anus relative to the perineum and various cross-sections of solid fecal material, while minimizing undue skin contact with such waste materials.” (col. 12: lines 33-38, emphasis added).

One skilled in the art would not be motivated to take the liquid-impermeable topsheet of *Kling*, made useable only by the large front opening, and construct the inner layer and opening of *Allen*, which tries to minimize the size of the opening.

The Examiner has not established a *prima facie* case of obviousness. Applicants respectfully request that this rejection be withdrawn.

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For the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-3016.

Respectfully submitted,

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